

REMARKS

Applicant thanks the Examiner for the very thorough consideration given the present application.

Claims 1-26 are now present in this application. Claims 1, 9 and 21 are independent.

Claims 1, 9 and 21 have been amended.

Reconsideration of this application, as amended, is respectfully requested.

Priority Under 35 U.S.C. § 119

Applicant thanks the Examiner for acknowledging Applicant's claim for foreign priority under 35 U.S.C. § 119, and receipt of the certified priority document.

Information Disclosure Citation

Applicant thanks the Examiner for considering the reference supplied with the Information Disclosure Statement filed July 18, 2003, and for providing Applicant with an initialed copy of the PTO-1449 form filed therewith.

Rejection Under 35 U.S.C. § 102

Claims 1-26 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 5,632,002 to Hashimoto et al. ("Hashimoto"). This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

A prior art reference anticipates the subject matter of a claim when that reference discloses every feature of the claimed invention, either explicitly or inherently. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) and Hazani v. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed Cir. 1997). While, of course, it is possible that it is inherent in the operation of the prior art device that a particular element operates as theorized by the Examiner, inherency may not be established by probabilities or possibilities. What is inherent, must necessarily be disclosed. In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) and In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

During patent examination the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

If the PTO fails to meet this burden, then the applicant is entitled to the patent. However, when a *prima facie* case is made, the burden shifts to the applicant to come forward with evidence and/or argument supporting patentability. Patentability *vel non* is then determined on the entirety of the record, by a preponderance of evidence and weight of argument, *Id.*

Moreover, as stated in MPEP §707.07(d), where a claim is refused for any reason relating to the merits thereof it should be "rejected" and the ground of rejection fully and clearly stated.

Additionally, findings of fact and conclusions of law by the USPTO must be made in accordance with the Administrative Procedure Act, 5 U.S.C. § 706(A), (E) (1994). Zurko v. Dickinson, 527 U.S. 150, 158, 119 S.Ct. 1816, 1821, 50 USPQ2d 1930, 1934 (1999).

A claim limitation is inherent in the prior art if it is necessarily present in the prior art, not

merely probably or possibly present. Rosco v. Mirro Lite, 304 F.3d 1373, 1380, 64 USPQ2d 1676 (Fed. Cir. 2002). The dispositive question regarding anticipation is whether one skilled in the art would reasonably understand or infer from the prior reference's teaching that every claim feature or limitation was disclosed in that single reference, Dayco Products, Inc. v. Total Containment, Inc., 329 F.3d 1358, 1368, 66 USPQ2d 1801 (Fed. Cir. 2003).

Applicant respectfully submits that independent claims 1, 9 and 21 are not anticipated by Hashimoto.

As amended, claim 1 positively recites a combination of features, including (1) a communication connector connected with a communication line to control a transmission of an e-mail data and an e-mail audio data, the communication connector comprising (a) a controller to control receiving and sending e-mail data pertaining to an e-mail and to control a conversion from the received e-mail data into e-mail message data, contents and texts of the e-mail and (b) an audio data generator to generate an audio signal to convert the e-mail message data into audio data containing contents of the e-mail and to transmit the audio data containing contents of the e-mail message to a client through the communication connector upon client request; (2) a memory to store the e-mail data, the e-mail message data, and the audio data containing contents of the e-mail; and wherein the stored audio signal containing contents of the e-mail message data is converted into an audio signal in the audio data generator and is outputted through the communication connector to a client.

Hashimoto does not disclose this combination of features. For example, it appears to applicant that Hashimoto does not store e-mail data converted to audio and then transmit that

converted audio to a client from a memory. It appears that Hashimoto does not store its converted audio data before communicating it to a client. See, for example, Fig. 75 of Hashimoto, and the discussion in Hashimoto of embodiments fifteen and sixteen from col. 50 through col. 55 of Hashimoto.

With respect to claim 9, claim 9, as amended, positively recites a combination of features, including (1) storing an e-mail when the e-mail is received; (2) converting the received e-mail into e-mail message data and storing the e-mail message data, contents and texts of the e-mail; (3) identifying a client's identification when a client requests an e-mail; (4) converting the e-mail message data to audio data; (5) saving in a memory the converted audio data; and (6) transmitting the saved converted audio data to the client as an audio signal, wherein the converted audio data stored in a memory is attached in the e-mail message data and reproduced audibly as part of the audio signal, the audio message data pertaining to certain data which is not audibly reproduced.

Hashimoto does not disclose this combination of features. For example, it appears to applicant that Hashimoto does not store e-mail data converted to audio and then transmit that converted audio to a client from a memory. It appears that Hashimoto does not store its converted audio data before communicating it to a client. See, for example, Fig. 75 of Hashimoto, and the discussion in Hashimoto of embodiments fifteen and sixteen from col. 50 through col. 55 of Hashimoto.

With respect to claim 21, claim 21, as amended, positively recites a combination of features, including (1) detecting, from a user, a request to access an e-mail stored in a server; (2) verifying

contents of said server upon detecting the user request; (3) converting at least a portion of the e-mail into audio data; (4) saving the converted audio data in a memory; (5) conveying the saved converted audio data to the user by simulating a voice indicating a gender of a sender of the e-mail, wherein said verifying is performed without going through an intermediary between said server and said user, wherein said portion of the e-mail is a header portion of the e-mail, a body of the e-mail includes texts, and the texts are converted into standard code format, and wherein an audio message data stored in a memory is audibly reproduced during the conveying step, the audio message data pertaining to certain data which is not audibly reproduced.

Hashimoto does not disclose this combination of features. For example, it appears to applicant that Hashimoto does not store e-mail data converted to audio and then transmit that converted audio to a client from a memory. It appears that Hashimoto does not store its converted audio data before communicating it to a client. See, for example, Fig. 75 of Hashimoto, and the discussion in Hashimoto of embodiments fifteen and sixteen from col. 50 through col. 55 of Hashimoto.

Dependent claims 2-8, which depend from claim 1, dependent claims 10-20, which depend from claim 9, and dependent claims 22-26, which depend from claim 21, are allowable over the applied art at least for reasons stated above regarding the patentability of independent claims 1, 9 and 21, above.

Accordingly, reconsideration and withdrawal of the rejection of claims 1-26 under 35 USC § 102(e) are respectfully requested.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46, 472, at (703) 205-8000, in the Washington, D.C. area.

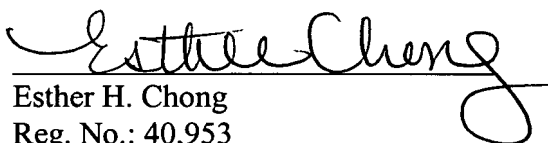
Prompt and favorable consideration of this Amendment is respectfully requested.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Date: September 11, 2007

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By: 
Esther H. Chong
Reg. No.: 40,953
P.O. Box 747
Falls Church, Virginia 22040-0747
Telephone: (703)205-8000